

### **REMARKS/ARGUMENTS**

This Application has been carefully reviewed in light of the Final Office Action mailed November 27, 2007. At the time of the Final Office Action, Claims 1-14 were pending in this Application. Claims 1-14 were rejected. Applicant respectfully requests reconsideration and favorable action in this case.

#### **Drawing Objections**

The Examiner requested that to shade the rotor, vanes, cam ring, side plate, pump casing with the shading scheme which represents a plastic. Applicant respectfully disagrees. The present application does not require all these elements to be made of plastic. According to claim 1, only the rotor needs to be made of plastic. The specification states that the vanes and/or the cam ring and/or the side plate and/or the pump casing can be made of plastic. However, the specification does not state that these elements have to be made of plastic. See, specification, page 3, paragraph [0008] and page 4, paragraph [0010] The specification merely states that it can be advantageous to make these parts from plastic material. See, specification, page 4, paragraph [0013] and [0014]. Hence, the different variations shown in the figures are supported by the specification and Applicant believes that no amendments to the drawings are required.

#### **Claims Objections**

Claims 1, 4, 5, 11 and 12 are objected to, in that their subject matter needs to be incorporated into the specification and the drawings. Applicant respectfully submits that it is unclear what the Examiner objects to. In particular, Applicant requests which rule this objection is based upon.

Applicant believes that the current set of claims is fully supported by the specification and does not require any amendment to the specification.

**Rejections under 35 U.S.C. §103**

Claims 1, 2, 6, 8, 9 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Publication No. JP 62-000684 filed by Taguchi ("Taguchi"). Applicant respectfully traverses and submits Taguchi does not render the claimed embodiment of the invention obvious.

Claims 1-4, 6, 8-11, and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Publication No. JP 56-151296 filed by Udonno et al. ("Udonno"). Applicant respectfully traverses and submits Udonno does not render the claimed embodiment of the invention obvious.

Claims 5 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Udonno in view of design choice. Applicant respectfully traverses and submits the cited art does not render the claimed embodiment of the invention obvious.

Claims 7 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Udonno in view of design choice as applied to Claims 1 and 8 above, and further in view of German Publication No. DE 1005007602 filed by Grossner ("Grossner"). Applicant respectfully traverses and submits the cited art does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In the last response, Applicant argued that “to captively mold the spring elements into the rotor” is not met by either *Taguchi* or *Udoni*. The Examiner stated that a recitation of the product by process claim which is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicant to come forward with evidence establishing an unobvious difference between the two.

However, Applicant argued that the prior art *Taguchi* or *Udoni* are not showing identical limitations with respect to the independent claims. Claim 1 requires that the spring elements are an integral part of the rotor. The term “integral” means that spring and rotor form a single element. This is accomplished by captively molding the spring elements into the rotor. Thus, rotor and spring elements become inseparable and form a single integral element. The current claim language does not leave room for any other interpretation. Moreover, the specification clearly supports this by characterizing this as a “one piece implementation of rotor and spring elements”. See, specification, paragraph [0009]. Thus, any construction of rotor and spring elements that consist of two separable elements do not fall under the current claim limitation “the spring elements being an integral part of the rotor.”

*Taguchi* discloses a rotor 14 into which holding elements 18 are inserted. A corrugated spring 17 is fitted to a holding element. Besides the fact that *Taguchi* discloses three separate elements, the holding element 18 is apparently not part of the rotor 14. Thus, spring 17 cannot form an integral part of the rotor 14. Moreover, even if holding element 18 is considered to be part of the rotor, which Applicant does not concede, holding element 18 and spring 17 also do not form an integral part because both elements are kept separate from each other, in other words, they can at any time be separated from each other.

*Udoni* clearly disclose a single actuating body 23 which is housed in a concave part 22. The rotor of *Udoni*'s vane pump is identified with numeral 3 and is kept completely separate from actuating body 23. Thus, Applicant respectfully requests how the term “housing” can be interpreted to encompass the limitation “the spring elements being an integral part of the rotor.” Because the spring element and the rotor 3 are clearly two separate elements, *Udoni* does not render the current independent claim 1 obvious.

Neither *Taguchi* nor *Udoni* disclose that rotor is made of plastic. The Examiner stated that using plastic as a material for the rotor is a mere design feature which is obvious to a person skilled in the art. Applicant respectfully disagrees. To accomplish the limitation of making the spring elements an integral part of the rotor the rotor needs to be "moldable" as further claimed by the limitation that the spring elements are captively molded into the rotor. Hence, the fact that the rotor is made of plastic is not a mere design choice. It is necessary, to ensure that the spring elements can form an integral part of the rotor.

Independent Claim 8 comprises a similar limitation as claim 1 and is therefore patentable as well. Applicant respectfully submits that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicant respectfully requests reconsideration and allowance of the dependent Claims. Applicant reserves the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

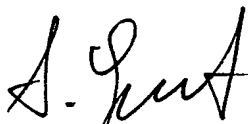
**CONCLUSION**

Applicant has made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2545.

Respectfully submitted,  
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